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LEYDIG VOIT & MAYER  
TWO PRUDENTIAL PLAZA  
SUITE 4900  
180 NORTH STETSON  
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EXAMINER

CALLAHAN, P

ART UNIT

PAPER NUMBER

2767

DATE MAILED:

04/18/00

*10*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/981,461**

Applicant(s)  
**Feldbau et al.**

Examiner  
**Paul Callahan**

Group Art Unit  
**2767**



☒ Responsive to communication(s) filed on Feb 16, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 64-161 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 64-66, 68, 69, 71-80, 92-98, 100, 101, 103-111, 123-127, 131-134, 13 is/are rejected.

☒ Claim(s) 67, 70, 81-91, 99, 102, 112-122, 128-130, 135, 136, 141-143, 146, 14 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 64-161, as amended by Applicant's communication received in this office Feb. 16, 2000, have been examined.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

3. Claims 87, 88, 118, and 119 contain the phrase; "... an information element purported to match ... ", this claim language is unclear as to its' meaning and renders the claims indefinite.

These claims are therefore rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

### ***Response to Arguments***

4. Applicant's arguments filed Feb. 12, 2000 have been fully considered but they are not persuasive.

Applicant's arguments based upon the discussion of the active vs. passive roles played by the communicants and the authenticator, posited in traverse of those claim rejections based on anticipatory teachings of the Bouricius et al. reference, fail to distinguish the instant invention *as*

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*claimed* from that taught by Bouricius. The instant invention, *as claimed*, fails to completely incorporate those features mentioned in the posited argument, that would patentably distinguish the instant invention from that taught by Bouricius.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 64-66, 69, 71-79, 92-96, 98, 100, 101, 103-110, 123-127, 131, 132, 134, 137-140, 144, 145, 149-151, 153, 154 and 160 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouricius et al. (U.S. Patent 4,326,098) and Official Notice taken as detailed below.

Claims 64 and 75

Bouricius et al. disclose a system, based on the concept of a vault or central authority, for authenticating that certain information has been transmitted from a sender via a dispatcher (e.g. vault) to a recipient. Bouricius et al. disclose a means for providing a set A comprising information on the contents of the information being electronically transmitted, a time indication associated with said dispatch and information describing the destination of said dispatch. (col. 9:

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13-30) Bouricius et al. disclose encrypting and step-coding the information to resist or indicate tampering by either the sender or receiver. (col. 9: 31-46) Bouricius et al. disclose associating and securing the dispatch-related information with the contents by generating authorization-information. (col. 9: 24-26 and 31-46, where the authorization information is the original ciphertext from the sender to be later used for arbitration if a dispute arises.)

Although Bouricius does not specifically teach an authenticator functioning as a non-interested third party with respect to the sender and the recipient, such an authenticator acting in such a manner is a feature that is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated this feature into the method of Bouricius et al. It would have been desirable to do so as this would increase the security of the system.

Claim 65

Bouricius et al. disclose associating the time of the dispatch. (col. 9: 24-26)

Claim 66

Bouricius et al. disclose dispatch-related information comprising an indication of identification associated with the sender and recipient. (col. 9: 15-16)

Claims 69, 71 and 72

Bouricius et al. disclose the contents are provided from the sender by electronic means over a communication network using a terminal. (abstract)

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Claims 73, 77 and 78

Bouricius et al. disclose authenticating the identity of the sender and/or recipient. (col. 9: 22-24 and 53-55)

Claim 74

Bouricius et al. do not explicitly disclose a means for providing the dispatched information to the dispatcher for electronic transmission to said recipient. However, this feature is inherent because the vault in the Bouricius et al. system acts as the dispatcher and all dispatch information and authentication information is transmitted to all concerned parties.

Claim 76

Bouricius et al. disclose the vault generating the time of dispatch. (col. 9: 24-26)

Claim 79

Bouricius et al. disclose providing an output of the authentication-information in electronic form. (col. 9:31-46)

Claim 92

Bouricius et al. disclose encrypting the message with the sender's key for later authentication purposes. (col. 9: 13-20)

Claim 93

Bouricius et al. disclose using a register containing the names of all authorized users of the vault. (abstract)

Claims 94-96, 98, 100, 101, 103-109, 123

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The Applicants' claimed method is the methodology used in the Applicants' claimed apparatus. Therefore, claims 94-96, 98, 100, 101, 103-109 and 123 are rejected as applied to claims 64-66, 69, 71-74 and 76-79.

Claim 110

Bouricius et al. disclose providing an output to the sender, recipient and arbitrator. (col. 10: 17-20)

Claim 124

Bouricius et al. disclose using an authenticator associated with a party other than the sender. (col. 10: 17-24)

Claim 125

Bouricius et al. disclose a method for authenticating a dispatch and contents of the dispatch comprising: receiving content data representative of the contents of the dispatch and a destination of the dispatch (col. 9: 31-67 and col. 10: 17-24, where ciphertexts, C1 and C2, are used for authentication); providing a secure indicia relating to a time of transmission of the dispatch (col. 9: 22-26 and 60-67); and associating the secure content data with the secure dispatch record data (col. 9: 24-30 and col. 10: 1-5 where the ciphered content, C1 and C2, are associated with a step-cipher, ST1 and ST2).

Claims 126, 127, and 134

The limitations are identical in scope to those found in respective dependent claims 74, 79 and 92. Therefore, claims 126, 127 and 134 are rejected as applied to claims 74, 79 and 92.

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Claim 131

Bouricius et al. disclose the time related indicia source being located at the vault, sender and receiver locations. (col. 9: 13-46, where the correspondents' clocks are external to the vault)

Claim 132

Bouricius et al. disclose the vault generates the time related indicia. (col. 9: 24-26)

Claims 137-140, 144 and 145

The Applicants' claimed authenticator performs the Applicants' claimed method for authenticating. Therefore, claims 137-140, 144 and 145 are rejected as applied to claims 125-127, 131, 132 and 134.

Claims 149-151, 153 and 154

The limitations in the Applicants' claimed information dispatch system are a combination of the limitations in previous claims. Therefore, claims 149-151, 153 and 154 are rejected as applied to claims 64, 79, 92, 94, 131, 132 and 137.

Claims 160

Bouricius et al. disclose providing a representation of either of said information elements. (col. 10: 20-25, where information elements are contained with ciphertexts, C1 and C2)

Bouricius et al. disclose verifying by match the two ciphertexts which contain content data, addresses of sender and receiver, and the time of dispatch. (col. 9: 13-65)



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8. Claims 68, 80, 97, 111, 133, 147, 155, 158 and 161 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouricius et al. (U.S. Patent 4,326,098) as applied to claims 64, 94, 125, 137, 149 and 160 above and in view of Official Notice taken as detailed below.

Claims 68 and 97

Bouricius et al. disclose authentication-information having an electronic form. Bouricius et al. do not disclose each element within the authentication-information can have a different form selected from the group consisting of the following forms: a paper document, microfiche and electronic information. Official notice is taken that paper documents and microfiche are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the Bouricius et al. system to use paper documents or microfiche for the convenience of the user.

Claims 80, 111, 133, 147 and 155

Bouricius et al. do not disclose storing the authentication-information in the vault. Bouricius et al. do disclose storing the authentication-information in storage outside the vault. (Figure 2, col. 11: 43-51) It would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to combine the storage elements and the vault into one apparatus in the Bouricius system for the advantage of having all authentication and storage operations occur at one location.

Claim 158

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Bouricius et al. do not disclose generating a paper document printout of said electronic content data to be dispatched to said recipient via a selected manual delivery service. Official notice is taken that paper printouts and manual delivery services are old and well known in the art. As applied to claim 94, it would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the Bouricius et al. system to include a paper printout of the content data and the subsequent manual delivery for the advantage of allowing the recipient to visually verify the received message.

Claim 161

Bouricius et al. do not disclose using a verifiable digital signature scheme. Official notice is taken that verifiable digital signature schemes are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the Bouricius et al. system to use a verifiable digital signature scheme for the advantage of creating a secure representation of the content that can be later verified for authenticity.

10. Claim 159 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier,

Applied Cryptography, 1st edition in view of Official Notice taken as detailed below.

Schneier explains a public-key certificate. (page 426, where the content of the dispatch is the public-key) The public key certificate comprises content data (public key), dispatch record data including time indicia (issue date) and the destination (user). The certificate is secured and authenticated through the digital signature applied by the issuing authority (dispatcher).

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Official Notice is herein taken that authenticators acting as non-interested third parties are old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated this feature into the system of Schneier. It would have been desirable to do so as this would increase the security of the system.

*Allowable Subject Matter*

11. Claims 67, 70, 81-91, 99, 102, 112-122, 128-130, 135, 136, 141-143, 146, 148, 152, 156, 157 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication from the Examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The Examiner can normally be reached Monday-Thursday from 9 A.M. to 4 P.M.

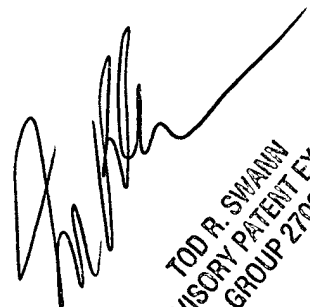
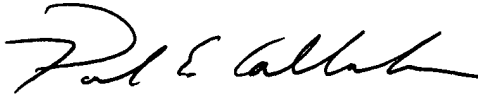
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tod Swann, can be reached at (703) 308-7791.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

4/12/2000

**Paul E. Callahan**  
**Patent Examiner, Art Unit 2767**  
**US Patent and Trademark Office**



**TOD R. SWANN**  
**SUPERVISORY PATENT EXAMINER**  
**GROUP 2700**